

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUL 25 2007

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ERICH KAST, HANS-JOACHIM WILKE and PETER WEILAND

Application 10/686,037

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on July 14, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

In section “**(9) Grounds of Rejection**”, p. 3 of the Examiner’s Answer mailed May 3, 2006, instead of stating the Grounds of Rejections of the appealed claims, the Examiner has chosen to refer to the prior Office Action mailed on 23 March 2005 for an explanation of the rejected claims.

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The Manual Of Patent Examining Procedure (MPEP) 1207.02 (8<sup>th</sup> ed., Rev. 3 August 2005) which was controlling at the time the Answer was written, ( as well as the current MPEP revision) states in part:

If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save time in preparing the examiner's answer required by 37 CFR 41.39 by copying a rejection from a prior Office action and then pasting the copied rejection into the answer. *An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer.* Of course, if the examiner feels that some further explanation of the rejection is necessary, he or she should include it in the ground of rejection set forth in the answer. (emphasis added.)

As per the above, it is no longer permissible to incorporate a prior Office action into an examiner's answer, simply by reference to the action alone. The action (or parts thereof) must be physically inserted into the answer. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the examiner to submit a revised Examiner's Answer alleviating the discrepancy noted above by vacating the answer and submitting a substitute Examiner's Answer that either:

- a.) contains a copy of the prior Office Action referenced in the Grounds of Rejection, (if the examiner wishes to maintain this course of action), or

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b.) fully restates the grounds of rejections of the appealed claim in the usual manner,  
and for such further action as may be appropriate.

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